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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/706,431	11/03/2000	Jay S. Walker	97-169X	7036

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EXAMINER
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BROCKETTI, JULIE K

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 01/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/706,431

Applicant(s)

WALKER ET AL.

Examiner

Julie K Brockett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 January 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 36-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 36-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 36 and 37 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 now states, "in response to expiration of a period of time that is measured from a time of player selection of the subject game element having the first class..." This is new matter. The specification describes starting the period of time from a point where a card is dealt, not from a point where a player selects the subject game element, i.e. card. The player does select the deal button however this is not considered a subject game element.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 41-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 41-46 are

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indefinite since they are directed towards an apparatus or a medium and then later in the claims become dependent on the method of a previous independent claim. For example, the applicant must include all of the limitations of claim 1 in claim 41 and can not just refer to them using the phrase "perform the method of claim 1". This is confusing and it is not understood if these claims are meant to be dependent on claims 1, 38 or 40 or are independent claims.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 40, 45 and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Gerfin, U.S. Patent No. 3,735,982. Gerfin discloses an electronic card game machine. A game of chance is conducted by generating a subject game element, i.e. card, having a first class, i.e. suit or rank. The subject game element is displayed, thereby, an indicia of the first class is displayed (Fig. 1, col. 1 lines 39-44). A second class is assigned to the subject game element in response to an expiration of a period of time. For example, a card will be displayed on the transparency. The flip-flop circuits controlling the display switch to a first output state, which enable the respective clock

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oscillators, which then apply clock pulses to the respective display drivers. Each clock pulse is a certain frequency, i.e. a period of time. Moreover, after each clock pulse the cards are changed and displayed, i.e. assigned a second class, and the indicia of the first class is erased (col. 3 lines 55-67; col. 4 lines 1-20). The player may actuate a lock button to prevent the subject game element, i.e. card, from expiring. The player presses the push-button switch associated with a particular card, which then inhibits the operation of the respective clock oscillator thereby preventing the card from changing (col. 3 lines 37-42). The game machine contains a storage device, and a processor in communication with the storage device for storing a program for controlling the processor and a medium encoded with the program.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 38, 39, 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerfin in view of Hung, U.S. Patent No. 3,961,473. Gerfin discloses a game of chance conducted by generating a subject game element, i.e. card, having a first class, i.e. suit or rank. The subject game element is

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displayed, thereby, an indicia of the first class is displayed (Fig. 1, col. 1 lines 39-44). Gerfin lacks in disclosing an indicia including a countdown display representing the forthcoming expiration of the first class corresponding to the subject game element. Hung teaches of an electronic chess timer. The timer comprises an oscillator and memory connected to a display which indicates in digital form the number of minutes of play that are represented by the signals stored in memory (See Hung abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a countdown timer display in the invention of Gerfin. Countdown displays are well known as in Hung. Players like to know how much time they have left to complete a move, etc. For example, in Gerfin, a player would like to know how much time they have left to activate the push-button switches to lock the card into place. By players being aware of how much time they have left, they can make better decisions on how to play the game.

### ***Allowable Subject Matter***

Claims 1, 36, 37, 41 and 42 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, first or second paragraph, set forth in this Office action.

### ***Response to Amendment***

It has been noted that claim 1 has been amended. New claims 41-46 have been added.

### ***Response to Arguments***

Applicant's arguments filed January 14, 2002 have been fully considered but they are not persuasive.

The Applicant argues that Gerfin does not disclose the limitation that the period of time which expires "is measured from a time of player selection of the subject game element having the first class." The Examiner agrees, however; this limitation is new matter not previously described in the specification. Consequently, the claim remains rejected.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves **or in the knowledge generally available to one of ordinary skill in the art.** See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Gerfin teaches of an electronic card game machine and Hung teaches of a chess timer. The Examiner notes that it is well known throughout the art to use countdown timers and it would have been obvious to one of ordinary skill in the art at the time the invention

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was made to include a countdown timer display in the invention of Gerfin. Players like to know how much time they have left to complete a move, etc. this is knowledge generally available to one of ordinary skill in the art. For example, in Gerfin, a player would like to know how much time they have left to activate the push-button switches to lock the card into place. By players being aware of how much time they have left, they can make better decisions on how to play the game. Consequently, the Examiner has provided a prima facie case for obviousness. The Applicant also alleges that Hung teaches of a manual countdown timer and the Applicant's timer is not manual. The Examiner notes that non-manual timers are also well known throughout the gaming art. For example in many video games such as Super Mario Brothers, a timer counts down as a player completes a level.

The Applicant alleges that a card in Gerfin does not "expire after a predetermined amount of time and that Gerfin does not teach or suggest the limitation of claim 40 of "actuating a lock button to prevent the subject game element from expiring". The Examiner disagrees. Gerfin clearly discloses giving players a predetermined amount of time to select a flashing card before one is automatically selected. After each flip-flop cycle the cards expire and another card is shown. Consequently, players may use push buttons to lock in a specific card and prevent that card from changing any further.

**Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K Brockett whose telephone number is 703-308-7306. The examiner can normally be reached on M-F 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703-308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is 703-306-5648.

  
Julie Brockett  
January 24, 2002

  
VALENCIA MARTIN-WALLACE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700

**6/18/01**

**The below text replaces the pre-printed text under the heading "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.**

**INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

**1. Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

**2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made other than correction of informalities, unless the examiner has approved the proposed changes.

**Timing of Corrections**

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.